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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,260	10/21/2003	Scott L. Adriaansen	SP03-144	5452
22928	7590	08/09/2005	EXAMINER	
CORNING INCORPORATED			DANIELS, MATTHEW J	
SP-TI-3-1			ART UNIT	
CORNING, NY 14831			PAPER NUMBER	
			1732	
DATE MAILED: 08/09/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/691,260

Applicant(s)

ADRIAANSEN ET AL.

Examiner

Matthew J. Daniels

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 and 14-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-7, 14-19, drawn to an apparatus, classified in class 198, subclass 345.1.
 - II. Claims 8-13, drawn to a method, classified in class 264, subclass 40.1.
2. Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus can be used to practice another and materially different process, such as orienting paper and printing on the paper.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, recognized divergent subject matter, and because the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Robert Carlson on 18 July 2005 a provisional election was made **with** traverse to prosecute the invention of Group II, claims 8-13. Affirmation of this election must be made by applicant in replying to this Office action. Claim 1-7 and 14-19 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claim 13** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim is drawn to “the first and second sections of the extrudate are separated from one another.” It is unclear to the Examiner how the first and second sections of the extrudate are separated from one another. In one interpretation, the first and second sections are separated from one another in the cutting the extrudate step recited in Claim 8. However, Claim 13 fails to further limit the parent claim because cutting is interpreted to inherently be separating the first and second sections from one another. It is unclear to the Examiner how the subject matter in Claim 13 is different from that sought in the cutting step of Claim 8. Appropriate revision is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 8, 12, and 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Avery (USPN 5205991) in view of DeMasters (USPN 5431866). **As to Claim 8**, Avery teaches a method of extruding a plasticized ceramic extrudate comprising

- b) supporting the extrudate on an extrudate support (Fig. 2, Items 12, 22, 23),
- c) cutting the extrudate to form a cut section of the extrudate (Fig. 2, Item 25),
- e) transferring the cut section of the extrudate along a length of the extrudate support while preventing any orientation change of the cut section (inherent in the air bearings of Fig. 2, Items 22, 23)

Avery appears to be silent to the other claimed limitations. However, they all would have been prima facie obvious over DeMasters who teaches:

- a) applying a reference mark to extrudate as it exits the extrusion die (Fig. 3, Items 46, 48)
- d) correcting the orientation of the section of the extrudate in response to a reference mark misalignment (2:59-3:37)
- f) visually inspecting the orientation of the extrudate (2:59-3:37)

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of DeMasters into that of Avery in order to provide a sensor means which acts to detect any rotation in the extrudate which might cause print printed on the pipe by the printing wheel to wander over the diameter of the pipe and correct for the rotation of

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the pipe (DeMasters, 4:15-19). **As to Claim 12**, Avery teaches supporting the extrudate on an air bearing (Fig. 2, Items 22, 23). **As to Claim 13**, in Avery's method, the first and second sections of the extrudate are inherently separated (See Fig. 1, Log (11) and Item 17), and the extrudate is transferred between a first section and a second section (See Avery's Fig. 1, arrow beside Item 17).

8. **Claims 9, 10, and 11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Avery (USPN 5205991) in view of DeMasters (USPN 5431866), and further in view of Nelson (USPN 4906170). Avery and DeMasters teach the subject matter of Claim 8 under 35 USC 103(a) above. **As to Claim 9**, DeMaster's teaches a reference mark (Fig. 4, Items 46 and 48) and ink (3:38-45), but Avery and DeMasters are silent to applying the reference mark with an inkjet. However, Nelson teaches applying an inkjet mark to the extrudate (3:38-55). It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Nelson into that of Avery and DeMasters in order to provide DeMasters' reference marks using a quick, easy, and cost effective method (Nelson, 1:66-2:2) that is also very accurate, non-contacting, and can be controlled by a computer (Nelson, 3:43-46). **As to Claim 10**, DeMasters' method operated continuously, and therefore must have visually inspected both first and second ends of the extrudate in order to know when to energize and de-energize the alignment correcting means (3:11-37). **As to Claim 11**, DeMasters' method inherently corrected corkscrew deformation in response to a visual inspection of the extrudate (3:11-37).

Conclusion

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9. The following teach that correcting the orientation of twisted extrudate was common at the time of the invention but are silent to an automated method for correcting the orientation using indicia:

Katz (USPN 2487972)

Kent (USPN 2487973)

Grossu (USPN 2715431)

Loewy (USPN 2352442)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Daniels whose telephone number is (571) 272-2450. The examiner can normally be reached on Monday - Thursday, 7:30 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on (571) 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJD 7/24/05



MICHAEL P. COLAIANNI
SUPERVISORY PATENT EXAMINER